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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,172	11/14/2001	Nicholas F. Baida	GK-BAIDA-102/500764.20002	6892

26418 7590 04/28/2004

REED SMITH, LLP
ATTN: PATENT RECORDS DEPARTMENT
599 LEXINGTON AVENUE, 29TH FLOOR
NEW YORK, NY 10022-7650

EXAMINER

HOOLAHAN, AMANDA J

ART UNIT PAPER NUMBER

2859

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/992,172

Applicant(s)

BAIDA, NICHOLAS F.

Examiner

Amanda J Hoolahan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 6, 7, 11, and 16-17 are rejected under 35 U.S.C. 102(b) as being unpatentable by USPN 6,178,655 to Potter et al. [hereinafter Potter].

Potter discloses a tape measure (40) in a case (15), said case having a bottom surface that rests on an object to be measured and having a vertical recess (70) at its front portion (see Figure 1); an indicator window (column 6, lines 46-47) located proximate the vertical recess and having an indication mark (30) positioned to be in line with measurement increments (130) arranged on said tape measure; a retractable cutting blade (60) housing integrally formed with said case and disposed proximate the vertical recess and receiving a retractable cutting blade wherein the cutting blade is aligned with the indication mark in the window so as to allow marking of or making of a cut on the object at the measurement increment that is in line with the indication mark using one and only one hand; a marker housing (80) integrally formed with said case and disposed proximate the vertical recess and receiving a marker wherein said marker is aligned with the indication mark in the window and said marker is positioned above the bottom surface of said case prior to marking so as to allow marking of an object at the measurement increment that is in line with the indication mark using one and only one hand; a second marker housing (50) integrally formed with said case, wherein said first and second marker housings are

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disposed on opposite sides of said indicator window (see Figure 1); said first marker housing is adapted to receive a blade and said second marker housing is adapted to receive a pencil or a pen (column 6, lines 54-57).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,178,655 to Potter et al. [hereinafter Potter] in view of USPN 4,649,649 to Fain.

Potter discloses the device as described above in paragraph 2 including a shell casing (15) for enclosing a tape measure, said casing having a bottom surface (see Figure 5a) that rests on an object to be measured and having a vertical recess (96) at its front portion, comprising an indicator window (column 6, lines 46-47) located in the vertical recess and having an indication mark (30) positioned to be in line with measurement increments (130) arranged on said tape measure; a marker housing (10) integrally formed with said casing and disposed proximate the vertical recess, and receiving a marker (200) wherein the marker is aligned with the indication mark in said window, and the marker housing and the marker are positioned above the bottom surface of said casing so as to allow marking of the object at the measurement increment that is in line with the indication mark using one and only one hand; wherein the marker is a blade (column 14, lines 15-16) and is aligned with the indication mark; the marker is a retractable (90,

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100) blade received in said marker housing (see Figure 5a); the marker is a lead pencil (column 15, lines 52-54) connected to at least one of said shells.

Potter does not disclose the device having a first concave shell; a second shell; and an attachment element that attaches said first concave shell to said second shell thereby enclosing the tape measure.

Fain discloses a device comprising a first concave shell (10); a second shell (12); and an attachment element (column 2, line 46, screws (not shown)) that attaches said first concave shell to said second shell thereby enclosing the tape measure. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to replace the tape measure, disclosed by Potter, with the tape measure having separate shells, as taught by Fain, in order for the user to be able to easily take apart the shells if a part needs to be replaced.

5. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Potter in view of USPN 5,430,952 to Betts.

Potter discloses the device as described above in paragraph 2 including said marker being adapted to used interchangeable leads or limestone (column 15, lines 52-57).

Potter does not disclose the tape measure including a nail hole at its exposed end.

With respect to claims 8 and 9: Betts discloses a tape measure having a nail hole (31) at its exposed end. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add the nail hole, as taught by Betts, to the end of the tape, disclosed by Potter, in order for the user to be able to hold the tape stationary.

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6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Potter in view of USPN 6,309,129 to Kageyama.

Potter discloses the device as described above in paragraph 2.

Potter does not disclose the device wherein the marker is a mechanical lead pencil molded into said case in a flush manner.

Kageyama discloses marker that is a mechanical lead pencil. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to replace the marker, disclosed by Potter, with a mechanical lead pencil, disclosed by Kageyama, in order for the user to be able to refill the marking piece more simply.

Response to Arguments

7. Applicant's arguments filed February 27, 2004 have been fully considered but they are not persuasive.

8. In response to applicant's argument that Applicant's device can be used using only a single hand, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the instant case, there is no reason to believe otherwise that the Potter device cannot be used using only a single

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hand. User could very easily hold case with a single hand, extend the tape with a finger on said single hand, and press down case with said hand to make a mark, thus making the device usable using only one single hand.

9. In response to Applicant's argument that the Potter device will not sit flat on the object being measured: This argument is not persuasive because the object being measured does not necessarily have to be flat. The object being measured can have any type of surface (flat or rugged) and therefore, Potter's device could very easily be used to measure and mark on any object. Also, as claimed, Applicant's device has a bottom surface that rests on the object being measured, as does the device disclosed by Potter.

10. In response to Applicant's argument that instant invention has a marker housing that is integrally formed with the case to make it more durable: This argument is not persuasive because Potter's device is also integrally formed as clearly shown in Figure 1. The term "integral" is defined as "formed as a complete unit." The device disclosed by Potter is therefore "integral" because it is a complete unit that can be used to measure and mark an object.

Conclusion

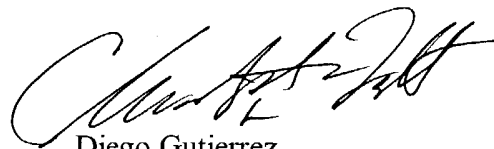
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda J Hoolahan whose telephone number is (571) 272-2246. The examiner can normally be reached on Monday through Friday 8:00 am to 4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ajh
April 22, 2004


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CHRISTOPHER W. FULTON
PRIMARY EXAMINER